

REMARKS

Preliminary Matters

Claims 1-12 are all the claims pending in the application. Applicant is amending claim 1 to clarify the recited elements, and not to narrow the claims. New claims 13-16 are added to further claim the subject matter of the invention. No new matter is submitted.

Applicant thanks the Examiner for considering the references cited in the Information Disclosure Statement filed on January 26, 2006.

Claim Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 1-6 and 10-12 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

In rejecting claims 1-6 and 10-12, the grounds of rejection state:

The claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide support for the limitation “non-radial spray channel.”

Office Action at page 2.

The test for enablement is whether one skilled in the art could make and use the claimed invention without undue experimentation. See *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737(Fed. Cir. 1988). It is not necessary to “enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim to that effect.” MPEP § 2164 (citing *CFMT, Inc. v. Yildup Int’l Corp.*, 349 F.3d 1333 (Fed. Cir. 2003)). In fact, “[i]n examining a patent application, the PTO is required to assume that the specification complies with the enablement provision of Section 112 unless it has ‘acceptable

evidence or reasoning' to suggest otherwise. . . . The PTO thus must provide reasons supported by the record as a whole why the specification is not enabling. . . . Then and only then does the burden shift to the applicant to show that one of ordinary skill in the art could have practiced the claimed invention without undue experimentation. . . ." *Gould v. Mossinghoff*, 229 USPQ 1, 13-14 (D.D.C. 1985) (citations omitted), *aff'd* in part, *vacated* in part on other grounds, and *remanded* sub nom. *Gould v. Quigg*, 3 USPQ2d 1302 (Fed. Cir. 1987); *see also* MPEP 2164.04.

Applicant respectfully submits that the Examiner has not overcome the presumption that the disclosure is enabling. The Examiner merely alleges that the "specification does not provide support for the limitation 'non-radial spray channel.'" (Office Action at page 2.) However, the specification describes a "non-radial spray channel" (*see at least* ¶¶ 0006, 0023 of current application, U.S. Pub. No. 2007/0267522) and depicts an embodiment of a "non-radial spray channel" (*see at least* FIG. 1, element 11). A person having skill in the art would be able to make and use a non-radial spray channel in view of the disclosure of the current application. As such, the Examiner's allegation that a "non-radial spray channel" is not supported by the specification is insufficient to overcome the presumption that the disclosure is enabling.

Claim Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-6 and 10-12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tate et al. (U.S. Pat. No. 3,680,793) in view of Workum (U.S. Pat. No. 4,673,110).

In rejecting claims 1-6 and 10-12, the grounds of rejection state:

Tate et al. discloses a fluid spray head in a fluid dispenser (see column 1, line 12) comprising an expulsion channel provided with a spray orifice 13 and a spray profile 14 formed in an end wall of the expulsion channel, the spray profile 14 comprising non-radial spray channel 17 opening out to a central spray chamber 16

disposed directly upstream from said spray orifice 13, the spray head being characterized in that the central axis of said spray orifice 13 is offset from the central axis of the spray chamber 16 by a distance x (see figure 2) Tate does not disclose a plurality of spray channels and that the distance x is less than 0.12 mm, and preferably less than 0.08 mm. However, Workum discloses a fluid spray head 11 with non-radial spray channels 28 (see figure 3.) Therefore, it would have been obvious to one having ordinary skill in the art to have provided the device of Tate et al. with a plurality of spray channels as suggested by Workum. Doing so would provide a high flowing rate swirling nozzle. With respect of the distance x , Tate et al. does not explicitly disclose that the distance x is less than 0.12 mm, and preferably less than 0.08 mm. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the device of Tate et al. with the distance x is less than 0.12 mm, and preferably less than 0.08 mm. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either claimed distance x or the distance x of the Tate et al. Therefore, it would have been an obvious matter of design choice to modify the device of Tate et al. to obtain the invention as specified in the claim and because such modification, i.e. choosing from a finite number of predictable solutions, is not of innovation but of ordinary skill and common sense. *KSR, International Co. v. Teleflex Inc.*, 550 U.S. (2007).

With respect to claim 4 and 5, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

Office Action at page 3-4.

Regarding claim 1, Applicant respectfully submits that it would not have been obvious to combine Tate with Workum. The Examiner acknowledges that Tate does not disclose a plurality of "non-radial spray channels." The Examiner alleges that it would have been obvious to combine the "orifices 28" in Workum with the spray device in Tate to achieve the "non-radial spray channels." Tate, however, indicates that there are drawbacks to using multiple "fluid inlets" because they are not feasible due to space considerations and the possibility of clogging.

(See Tate, col. 1, lines 57-68.) As such, Tate teaches away from the use of using a plurality of “non-radial spray channels” and one having ordinary skill in the art would not have combined Workum with Tate.

Furthermore, providing an offset distance of “less than 0.08 mm” would not have been obvious simply as a matter of design choice. The Examiner states that “with respect to the distance x, Tate et al. does not explicitly disclose that the distance x is less than 0.12 mm, and preferably less than 0.08 mm . . . It would have been obvious to a person of ordinary skill in the art to provide Tate et al. with the distance x is less than 0.12 mm, and preferably less than 0.08 mm.” Tate, however, discloses that to be effective, the offset distance must be in a certain “sector of the spiral chamber” and that it “should be between 0.005 and 0.015 inches [which equates to a distance between 0.127 mm and 0.381 mm]¹.” Tate teaches that it is beneficial to increase the offset and that it should be between 0.127 mm and 0.381 mm. Therefore, it would not have been obvious merely as a matter of design choice, as alleged by the Examiner, to reduce the offset distance to less than 0.08 mm.

Regarding claims 2-6 and 10-12, these claims depend from independent claim 1. As such, these claims are allowable at least by virtue of their dependency from claim 1.

New Claims

For additional claim coverage merited by the scope of the invention, Applicant is adding new claims 13-16. Applicant respectfully submits that new claims 13-16 are allowable over the prior art.

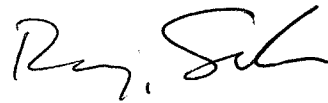
¹ The distance in millimeters was calculated by multiplying: inches x ($\frac{25.4 \text{ mm}}{1 \text{ inch}}$)

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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